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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/693,317

10/20/2000

Kia Silverbrook

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

LETT, THOMAS J

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

01/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/693,317

Applicant(s)

SILVERBROOK ET AL.

Examiner

Thomas J. Lett

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 2-6 have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3,4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soscia (US 6,636,332 B1) in view of DeClerck et al (US 6,437,849 B1).

Regarding claim 6, Soscia discloses an apparatus (reproduction system 10) for reproducing a visible image (image 20) depicted in a photograph, the photograph also carrying digitally encoded data printed in invisible ink (invisible indicia 40, col. 3, lines 34-38, col. 4, lines 5-19), the digitally encoded data having pixel values for all pixels in the visible image (the encoded data array 40 defines the digital image file and would therefore include the pixel values necessary for a successful visual reproduction of an image, col. 3, line 60 – col. 4, line 4), comprising:

a scanner means for scanning the digital data (sensor 150 for scanning, col. 6, lines 3-5) to produce a bit image with a plurality of copies of data relating to the visible image depicted in the photograph;

means for advancing the photograph through the scanner means (feedthrough, col. 6, line 4);

means for illuminating the photograph with invisible radiation (light source, col. 6, lines 22-30);

means for processing data output (processor 240, col. 6, lines 49-54) from the scanner means, the means for processing data including means for decoding the digitally encoded data (processor 240, col. 6, lines 42-44) scanned by the scanner means; and,

inkjet printer (printer 270, col. 6, lines 54-56) means for receiving data from the means for processing data (processor 240) to print the visible image depicted in the photograph, the data used to print the visible image being generated using only the digitally encoded data; wherein during use,

the means for decoding decodes one of the copies of the data relating to the visible image if decoding of the previous copy failed (the system of Soscia can obviously make more than one scan/copy of an original and can subsequently attempt to repeat the decoding process until it is successful with a latter copy).

Soscia does not teach the scanner means having a scan resolution greater than the print resolution of the digitally encoded data.

However, DeClerck et al teach of a scanner preferably having a scan resolution greater than a print resolution (see col. 3, lines 32-34). It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Patton by the teaching of Mui because it would have saved users a lot of effort of advancing the photograph manually.

Regarding claim 3, Soscia discloses an apparatus as claimed in claim 6 wherein said invisible ink is an infra-red absorbing ink, and wherein said invisible radiation is infra-red light (col. 4, lines 9-16).

Regarding claim 4, Soscia discloses an apparatus as claimed in claim 6 wherein said ink jet printer means includes means for printing out on a print media (recording medium 280) attached to said ink jet printer means both the visible image depicted in the photograph and the digitally encoded data (col. 6, lines 49-54).

3. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soscia (US 6,636,332 B1) in view of DeClerck et al (US 6,437,849 B1) as applied to claim 6 above, and further in view of Zhang (US 5,771,245).

Patton does not disclose expressly that the digitally encoded data is encoded and decoded using the Reed-Solomon process.

Zhang discloses using the Reed-Solomon process to encode/decode data (col. 4 lines 18-20).

Patton and Zhang are combinable because they are from the same field of endeavor, namely two-dimensional data encoding and decoding. Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to use the Reed-Solomon process, as taught by Zhang, as the encoding/decoding process in Patton's system.

The motivation for doing so would have been that the Reed-Solomon process is a well-known process in the art to protect encoded data (Zhang: col. 4 lines 18-20).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571) 272-7464. The examiner can normally be reached on 8-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TJL/
AU 2625

DOUGLAS Q. TRAN
PRIMARY EXAMINER

